Paper No. 29

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MICHAEL L. MAULDIN

Appeal No. 2002-0040
Application No. 08/937,392

ON BRIEF

Before HAIRSTON, BARRY, and LEVY, *Administrative Patent Judges*.
BARRY, *Administrative Patent Judge*.

DECISION ON APPEAL

A patent examiner rejected claims 4-6. The appellant appeals therefrom under 35 U.S.C. § 134(a). We reverse.

BACKGROUND

The appellant's invention concerns cataloging files found on the Internet. The appellant asserts that his invention enables entries in a catalog to be created for Internet files that have not been downloaded for examination. (Appeal Br. at 2.) Figure 9 of his specification represents the invention. A file 130 downloaded from the Internet that contains a hypertext link to another document, viz., "ig-care.html," is

shown. The link has associated link text, which reads "behavior page." The link and link text may be used to create an entry for an associated file 134 although the latter file has not been downloaded. (*Id.*)

A further understanding of the invention can be achieved by reading the following claim:

> 6. A method of constructing an entry in a catalog of files stored on a network, comprising:
>
> downloading files for processing;
>
> saving link text from the downloaded files and address information associated with said link text; and
>
> using the address information and the link text to create an entry in the catalog for a file not downloaded for processing.

Claims 4 and 6 stand rejected under 35 U.S.C. § 102(a) as anticipated by Duda et al. ("Duda"), *Content Routing in a Network of WAIS Servers Distributed Computing Systems*, Proceedings of the 14th Int'l Conference on Distributed Computing Systems, 1994, pp. 124-32. Claim 5 stand rejected under 35 U.S.C. § 103(a) as obvious over Duda.

OPINION

Rather than reiterate the positions of the examiner or appellant *in toto*, we address the main point of contention therebetween. The examiner asserts, "Duda et al. had specifically suggested construction of a global index (See Duda et al. Col. [sic] 127, lines 5-7)." (Examiner's Answer at 4.) He adds, "there is no difference between constructing an index and constructing a catalog." (*Id.*) The appellant argues, "Duda et al. do not teach the steps of creating an entry in a catalog corresponding to a network address of a second file which has not been downloaded, and assigning the link text as a description of the second file." (Appeal Br. at 6.)

"Analysis begins with a key legal question -- *what* is the invention *claimed*?" *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561, 1567, 1 USPQ2d 1593, 1597 (Fed. Cir. 1987). In answering the question, "the Board must give claims their broadest reasonable construction. . . ." *In re Hyatt*, 211 F.3d 1367, 1372, 54 USPQ2d 1664, 1668 (Fed. Cir. 2000). "Moreover, limitations are not to be read into the claims from the specification." *In re Van Geuns*, 988 F.2d 1181, 1184, 26 USPQ2d 1057, 1059 (Fed. Cir. 1993) (citing *In re Zletz*, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989)).

Here, claim 4 specifies in pertinent part the following limitations: "[a] method of constructing an entry in a catalog of files stored on a network, comprising . . . a second

file on the network and not downloaded; creating an entry in the catalog corresponding to a network address of the second file; and assigning the link text as a description of the second file." Similarly, claim 6 specifies in pertinent part the following limitations: "[a] method of constructing an entry in a catalog of files stored on a network, comprising . . . using the address information and the link text to create an entry in the catalog for a file not downloaded for processing." Giving the independent claims their broadest, reasonable construction, the limitations require creating an entry for a file not downloaded for processing in a catalog of files stored on a network.

"[H]aving ascertained exactly what subject matter is being claimed, the next inquiry must be into whether such subject matter is novel." *In re Wilder*, 429 F2d 447, 450, 166 USPQ 545, 548 (CCPA 1970). "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros., Inc. v. Union Oil Co.*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987) (citing *Structural Rubber Prods. Co. v. Park Rubber Co.*, 749 F.2d 707, 715, 223 USPQ 1264, 1270 (Fed. Cir. 1984); *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 1548, 220 USPQ 193, 198 (Fed. Cir. 1983); *Kalman v. Kimberly-Clark Corp.*, 713 F.2d760, 771, 218 USPQ 781, 789 (Fed. Cir. 1983)). "[T]here is no anticipation 'unless all of the same elements are found in exactly the same situation and united in the same way . . . in a single prior art reference.'"

Perkin-Elmer Corp. v. Computervision Corp., 732 F.2d 888, 894, 221 USPQ 669, 673 (Fed. Cir. 1984) (citing *Kalman v. Kimberly-Clark Corp*., 713 F.2d 760, 771, 218 USPQ 781, 789 (Fed. Cir. 1983).

Here, the examiner's position that "[a]s per claims 4 and 6, Duda et al. disclosed the invention," (Final Rejection at 2), seems to be that all the elements of the independent claims are found in Duda's invention. For its part, the reference describes Duda's invention as "based on *content routing*, an architecture that makes use of *content labels* for locating and accessing information in large distributed systems." Abs., ll. 6-9. The examiner equates the claimed "link text" to Duda's use of content labels asserting, "the content label is a link text which corresponds or [sic] a description of a second file. . . ." (Examiner's Answer at 4.) Opining that "Duda et al. had specifically suggested construction of a global index (See Duda et al. Col. 127, lines 5-7)," (*id.),* moreover, he asserts, "there is no difference between constructing an index and constructing a catalog." (*Id.*)

Although the reference mentions a global index, the examiner fails to show that the index is part of **Duda's** invention. To the contrary, Duda distinguishes its invention from the global index. Specifically, "[c]ontent routing based on content labels lies between the extremes of a global index and sending every query to every server." P. 127.

The reference even explains why Duda chose not to use a global index for its invention. Specifically, “the space needed for this approach is prohibitively large, and a global index is very difficult to keep up to date. In addition, there would still be some need to organize the heterogeneous data for browsing.” P. 127. Because the global index is not part of Duda’s invention, the examiner fails to show it is found in exactly the same situation and united in the same way as the claimed catalog of files stored on a network. The absence of such a showing "negates anticipation." *Kloster Speedsteel AB v. Crucible, Inc.,* 793 F.2d 1565, 1571, 230 USPQ 81, 84 (Fed. Cir. 1986). Therefore, we reverse the anticipation rejection of claims 4 and 6.

“[T]o establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the applicants.” *In re Kotzab*, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1316 (Fed. Cir. 2000) (citing *In re Dance*, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998); *In re Gordon*, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984)). “[T]he factual inquiry whether to combine references must be thorough and searching.” *McGinley v. Franklin Sports, Inc.*, 262 F.3d 1339, 1351-52, 60 USPQ2d 1001, 1008(Fed. Cir. 2001). “This factual question . . . [cannot] be resolved on subjective belief and unknown authority.” *In re Lee*, 277 F.3d

1338, 1343-44, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002). "It must be based on objective evidence of record." *Id.* at 1343, 61 USPQ2d at 1434.

Here, the examiner fails to allege, let alone show objective evidence of, the desirability of incorporating a global index into Duda's use of content routing based on content labels. We will not "resort to speculation," *In re Warner*, 379 F.2d 1011, 1017, 154 USPQ 173, 178 (CCPA 1967), about such desirability. Therefore, we reverse the obviousness rejection of claim 5.

CONCLUSION

In summary, the rejection of claims 4 and 6 under § 102(a) and the rejection of claim 5 under § 103(a) are reversed.

REVERSED

KENNETH W. HAIRSTON Administrative Patent Judge	)
LANCE LEONARD BARRY Administrative Patent Judge	) BOARD OF PATENT) APPEALS) AND) INTERFERENCES
STUART S. LEVY Administrative Patent Judge	)

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